

Remarks/Arguments:

I. Status

The Office Action dated September 14, 2005 (the "Office Action") provided an exceptionally detailed and readily comprehended recitation of the Examiner's basis for rejection.

In response to the Office Action, claim 21 has been amended to incorporate the limitations of claim 26 which is canceled herein and claim 27 has been amended to depend from claim 21. Additionally, claim 19 has been amended to be more clear. Thus, claims 14-25 and 27 are pending in this application. Reconsideration of this application, as amended, is respectfully requested.

II. The Rejection of Claims 14-15 and 17-19 Under 102(e)

In the Office Action, claims 14-15 and 17-19 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,622,174 B1 to Ukita et al. (hereinafter "Ukita"). Respectfully, Ukita fails to disclose all of the elements of claims 14-15 and 17-19.

Discussion Regarding Patentability of Claim 14

1. Claim 14

Claim 14, as previously amended, recites:

A method for generating revenue using electronic mail, comprising the steps of:
transmitting an e-mail message addressed to at least one email recipient from a first client computer to a host server through at least one computer network, wherein the e-mail message comprises an e-mail address of an e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body;

appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database;

transmitting the e-mail message from the host server to a second client computer through the at least one computer network based upon the e-mail address of the at least one e-mail recipient; and

displaying the e-mail message on the second client computer, wherein when the e-mail message is first displayed on the second client computer the advertisement software retrieval means is operable at the second client computer to retrieve at least one of the advertisements retrievably stored in the database for display with the e-mail message on the second client computer.

Claim 14, as previously amended, thus recites a method wherein an e-mail message is appended with advertisement retrieval software. When the email is displayed at the second client computer, the advertisement retrieval software retrieves the advertisement for display with the e-mail message.

2. Ukita Does Not Disclose Appending Advertisement Retrieval Software

The Examiner alleged that Ukita discloses appending advertisement retrieval software to an e-mail as recited in claim 14. (Office Action at page 2). Respectfully, Ukita does not disclose advertisement retrieval software.

Specifically, Ukita discloses that “advertisement information” is added to information in various communications. (Ukita at column 4, line 63 through column 5, line 1). As described at column 5, lines 1-5, the “advertisement information” that is added to the e-mail is the *advertisement* itself. In contrast, claim 14 is directed to appending software that is capable of *retrieving* an advertisement.

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. An advertisement is not the same as software which, when executed, causes the advertisement to be retrieved. Accordingly, because claim 14 recites a method of transmitting an e-mail wherein advertisement

retrieval software is appended to the e-mail and Ukita discloses appending the *advertisement itself*, the Applicants submit that claim 14 is patentable over the prior art.

Discussion Regarding Patentability of Claim 15

The Examiner has rejected claim 15 based upon the same prior art discussed above with respect to claim 14. Claim 15 depends from claim 14 and includes the same limitations discussed above with respect to claim 14 and other limitations. Therefore, for at least the same reasons set forth above with respect to claim 14, claim 15 is allowable over the prior art.

Discussion Regarding Patentability of Claim 17

The Examiner has rejected claim 17 based upon the same prior art discussed above with respect to claim 14. Claim 17 depends from claim 14 and includes the same limitations discussed above with respect to claim 14. Therefore, for at least the same reasons set forth above with respect to claim 14, claim 17 is allowable over the prior art.

Moreover, claim 17 further includes limitations similar to those discussed below with respect to claim 21 and is further patentable over the prior art for the reason set forth below with respect to claim 21.

Discussion Regarding Patentability of Claim 18

The Examiner has rejected claim 18 based upon the same prior art discussed above with respect to claim 14. Claim 18 recites a method for sending e-mail messages appended with advertising including the step of “appending advertisement retrieval software means to the e-mail message.” This is the same limitation, for purposes of this

response, as the limitation discussed above with respect to claim 14. Therefore, for at least the same reason set forth above with respect to claim 14, claim 18 is patentable over the prior art.

Discussion Regarding Patentability of Claim 19

The Examiner has rejected claim 19 based upon the same prior art discussed above with respect to claim 14. Claim 19 depends from claim 18 and includes the same limitation discussed above with respect to claim 18 and other limitations. Therefore, for at least the same reasons set forth above with respect to claim 18, claim 19 is allowable over the prior art.

III. The Rejection of Claims 21-25 and 27 Under 102(e)

In the Office Action, claims 21-25 and 27 were rejected under 35 U.S.C. 102(e) as being anticipated by Ukita. Claim 21, from which claims 22-25 and 27 depend, has been amended to incorporate limitations previously recited in claim 26. Accordingly, the Applicants respectfully submit that for the reasons set forth below, claims 21-25 and 27 are allowable over the cited art.

Discussion Regarding Patentability of Claim 21

1. Claim 21

Claim 21, as amended, recites:

A method for advertising using electronic e-mail comprising:
composing an e-mail on a first client computer
sending the e-mail to a recipient;
appending a sub-message associated with an advertisement to the e-mail at a host server while the e-mail is enroute to the recipient;
delivering the appended e-mail to a second client computer;

displaying with the second client computer the advertisement associated with the sub-message;
transmitting a return communication from the second client computer to the host server when the advertisement is displayed by the second client computer; and
accounting with the host server for advertising revenue and advertising expense in response to the receipt of the return communication.

Claim 21, as amended, thus recites a method wherein an accounting for the display of an advertisement on a second client computer is performed after the reception of a communication from the second client computer indicating that the advertisement has been displayed.

2. Ukita Does Not Disclose the Timing of the Accounting

The Examiner alleged that Ukita discloses accounting for advertising revenue. (Office Action at page 2). Respectfully, Ukita fails to disclose an accounting as recited in claim 21, as amended.

Specifically, the Examiner has cited to Ukita at column 1, lines 47-52 as disclosing the accounting for display of advertisements. Ukita does disclose the broad concept of “charging advertisement fees” to an advertiser. (Ukita at column 1, lines 47-52). Ukita fails to identify, however, the timing of the accounting or the basis for assessing the advertising fees. By way of example, it is possible that Ukita envisioned a flat rate fee paid before any services are rendered or a fee based upon the number of advertisements attached to communications regardless of the actual number of advertisements actually displayed.

In contrast, claim 21, as amended, recites a specific accounting scheme which is based upon receipt of a message indicating that the advertisement has actually been displayed. Thus, an accounting would not occur under the invention recited in claim 21

if an email having an advertisement attached is deleted without opening/reading the e-mail. This accounting method is not disclosed by merely "charging advertisement fees" to an advertiser.

Accordingly, because claim 21 recites a method of transmitting an e-mail wherein an accounting for the display of an advertisement on a second client computer is performed after the reception of a communication from the second client computer indicating that the advertisement has been displayed, and Ukita does not disclose such a limitation, the Applicants submit that claim 21 is patentable over the prior art.

Discussion Regarding Patentability of Claim 22

The Examiner has rejected claim 22 based upon the same prior art discussed above with respect to claim 21. Claim 22 depends from claim 21 and includes the same limitations discussed above with respect to claim 21. Therefore, for at least the same reasons set forth above with respect to claim 21, claim 22 is allowable over the prior art.

Moreover, claim 2 further includes limitations similar to those discussed above with respect to claim 14 and is further patentable over the prior art for the reason set forth above with respect to claim 14.

Discussion Regarding Patentability of Claims 23-25 and 27

The Examiner has rejected claims 23-25 and 27 based upon the same prior art discussed above with respect to claim 21. Claims 23-25 and 27 depend from claim 21 and include the same limitations discussed above with respect to claim 21 and other

limitations. Therefore, for at least the same reasons set forth above with respect to claim 21, claims 23-25 and 27 are allowable over the prior art.

IV. Claims 16 and 20

The Examiner has determined that claims 16 and 20 recite patentable subject matter. (Office Action at page 3). Claims 16 and 20 were objected to, however, for depending from a rejected claim. Claims 16 and 20 depend from claim 14. Because claim 14 is allowable for the reason set forth above, the Applicants respectfully submit that the objection to claims 16 and 20 has been overcome.

V. Conclusion

Applicants respectfully request entry of the amendments and favorable consideration of the application.

A prompt and favorable action on the merits is requested.

Respectfully Submitted,
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